processor readable code for causing a computer to determine whether those invitees are available during the requested time interval;

processor readable code for (a) causing a computer to invite the available invitees to attend at the requested time interval using the electronic mail address stored in the profile for each invitee[;], and (b) automatically updating the invitee's profile to thereby schedule the time interval in the invitee's profile based on the invitee's response to the invitation.

REMARKS

The Office Action has been reviewed and, in view of the following comments, reconsideration and allowance of all of the claims pending in the application are respectfully requested.

I. Status of the Claims

Claims 1, and 5-7 have been amended to clarify the language of the claims. The amendments are formal in nature and do raise new issues requiring further search and consideration. As such, entry of the amendment is respectfully requested.

II. Rejection of Claims 1-16 under 35 U.S.C. § 103(a)

Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,124,912 to Hotaling *et al.*("Hotaling") in view of U.S. Patent No. 5,903,845 to Buhrmann *et al.* ("Buhrmann"). This rejection is respectfully traversed for the reasons which follow.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicant's disclosure. *See* M.P.E.P. §§2143.01 and 2143.03.

In a proper obviousness determination, the changes from the prior art must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the claimed invention. *See In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). This includes what could be characterized as simple changes. *See, e.g., In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).

Only when the prior art teaches or suggests the claimed invention does the burden fall on the applicant to rebut that *prima facie* case. *See In re Dillon*, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc), *cert. denied*, 500 U.S. 904 (1991). However, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.

The rejection of claims 1-16 under 35 U.S.C § 103(a) as unpatentable over Hotaling in view of Buhrmann is respectfully traversed in that the references when combined do not disclose all of the limitations of the claimed invention. Moreover, there is no basis in the references from which it could be reasonably inferred that one of ordinary skill in the art would have been led or motivated to combine or modify the teachings of the references in the manner required to arrive at the claimed invention. Reliance on the above references is therefore not proper.

Hotaling discloses a meeting management device of a computer system which determines a meeting date and time for a specified group of invitees within a set of specified time parameters. A subset of the invitees are designated as critical along with any specified pieces of equipment and desired meeting sites. Remote from personal calendars of the invitees, the device compares available dates and times of each critical invitee with each other and that of any critical pieces of equipment and meeting sites. The comparison determines common available dates and times in which to schedule the meeting. *See Hotaling*, abstract.

Once a meeting has been "scheduled", *i.e.*, a tentative meeting time is selected, Hotaling discloses that an electronic mail invitation may be sent to each invitee. "The sending of an

invitee's invitation automatically updates the public templa[t]e field of his schedule record if he is a participant of the Meeting Management service **19** and is critical to this meeting and thus completes the cycle of Meeting Management **19**." *Id.* at col. 10, ll. 22-27. As such, Hotaling discloses that a meeting is scheduled by the mere act of determining an available time interval and sending an email notification. However, the invitee must personally update his private template to reflect his actual acceptance or non-acceptance of the scheduling invitation, and respond to the meeting coordinator outside of the Meeting Management service to truly *schedule* the meeting in his personal calendar. *See id.* at col. 10, ll. 28-68.

Contrasted to the above, the present independent claims provide that a time interval is scheduled and an invitee's profile is updated based on the invitee's response to an electronic mail invitation. Hotaling does not teach or suggest such an interactive, automated scheduling approach. Thus, under the claims of the invention, an invitee may decline a meeting at the proposed time even though the invitee is "available." Whereas in Hotaling, a meeting is "scheduled" without the invitee's prior acceptance or approval. In fact, the Examiner states that "Hotaling does not disclose selective update of the profile based on the invitee's response." *Office Action, Paper No. 7* at page 3.

However, the Office Action maintains that Buhrmann discloses selective updating of a profile. *See id.* Buhrmann discloses a personal information manager ("PIM") for updating a telecommunication subscriber's profile. According to Buhrmann, a subscriber enters personal information, such as personal schedule data, into a PIM. The PIM, either automatically, or based on additional profile requests entered by the subscriber, updates the subscriber's profile in the telecommunications system. Thereafter, telecommunication services, including call completion services and schedule message reminder services, are provided to the subscriber based on the updated subscriber profile data. *See Buhrmann*, abstract.

Buhrmann discloses a general method for updating a remote subscriber profile to include personal information data manually input into a PIM by the subscriber. Although the personal information data can relate to personal schedule information, Buhrmann is not directed to a system or process for scheduling time intervals among a *plurality* of subscribers, nor does it

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involve updating of the subscriber's profile based on the subscriber's response to an electronic mail invitation.

The Office Action maintains that "Hotaling discloses a method to restrict selection for a meeting by using the 'unavailable' function. The invention disclosed in Buhrmann is just an extension of this 'unavailable' functionality and it would have been obvious to add Burhmann's enhancement to Hotaling to improve this functionality." *Office Action, Paper No. 7*, at 3. In this regard, even if the Burhmann's "enhancement" of updating a user's profile to include times designated by the user as unavailable, such a combination would not result in the claimed invention. The references when combined still fail to disclose scheduling a time interval among a plurality of users by sending electronic mail invitations to potential invitees and automatically updating the invitees' profiles *based on the their responses to the invitation*. At most, this combination would result in a user's profile being updated based on the manual input of personal schedule information, *e.g.*, unavailable times.

Further, neither of the references, either taken alone or in combination, provide motivation to one of ordinary skill to modify the teachings of the references to arrive at the claimed invention. Neither of the references suggest the desirability of an interactive, automated scheduling system wherein a time interval is scheduled among a plurality of users by sending an electronic mail invitation to potential invitees, and automatically updating the invitees' profiles based on their responses to the invitation.

For at least these reasons, Applicants submit that the claims are patentable over Hotaling in view of Buhrmann. As such, withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, the application is believed to be in condition for allowance and notification thereof is respectfully requested. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at (202) 955-1894.

It is believed that no additional fees are required. However, in the event that any additional fees are due in connection with filing this amendment, the Commissioner is hereby authorized to charge all required fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Dated: October 6, 2000